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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,396	08/12/2003	Eli Aharoni	1222VIS-US	5471

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EXAMINER

BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/638,396

Applicant(s)

AHARONI, ELI

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

a. Therefore, the “forming a mounting hole in an IOL already implanted in an eye” (see claim 1) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

b. Therefore, the “mounting hole is offset from the center of said first IOL” (see claim 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

c. Therefore, the “mounting hole is tilted” (see claim 4 and claim 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 1, the limitation “the existing IOL” (see line 2) lacks antecedent basis.

b. Regarding claim 1, the limitation “without removing the existing IOL” (see claim 1, lines 1-2) and “forming a mounting hole in an IOL already implanted in an eye” (see claim 1, line 3) is indefinite as to the scope of the invention. It is not clear, from the claim language, if the “mounting hole” is pre-formed in the pre-existing IOL, or, if the “mounting hole” will be formed in situ in the pre-existing IOL (which is already implanted inside the eye). The drawing and the specification do not teach the necessary steps (i.e., make an incision, remove a portion of, etc.) on how to modify a pre-existing IOL (which is still inside the eye) in order to form a “mounting hole”.

c. Regarding claim 4, the limitation “said first IOL 12” (see line 2) lacks antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 and 7 are rejected, as best understood, under 35 U.S.C. 102(b) as being clearly anticipated by Lipshitz et al. (US 5,814,103 A).

As seen in Figures 1-7, Lipshitz et al. disclose an apparatus comprising (i) a first IOL (e.g., intraocular lens 12) formed with a mounting hole (e.g., Figure 5: centrally located mounting hole having female threads 54; Figure 6: offset mounting holes 68); and (ii) a second IOL (e.g., telescope 14) mounted in said mounting hole (see entire document). Said mounting hole(s) could be formed (or pre-formed) without removing the existing IOL (see column 2, lines 39-48; see column 5, lines 10-23).

6. Claims 2, 3, and 5-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gross et al. (EP 897 702 A2).

As seen in Figures 1-6, Gross et al. disclose an apparatus comprising (i) a first IOL (e.g., carrying lens 20) formed with a mounting hole (e.g., Figures 1 and 2: straight mounting hole; Figure 3: tilted mounting hole, as disclosed in column 4, lines 24-29); and (ii) a second IOL (e.g., telescope 18, having a variety of lenses inside) mounted in said mounting hole (see entire document).

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Conclusion


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Eggleston et al. (US 5,628,798 A), Lipshitz et al. (US 5,876,442 A), Peyman et al. (US 6,277,146 B1), and Gross et al. (EP 0 897 702 A2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

March 18, 2005



David H. Willse
Primary Examiner